




| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 380412000110 | | | | | | |
|--|---|--|--|---|---|--|--|--|
| | Application Number 10/829,165 | Filed April 22, 2004 | | | | | | |
| | First Named Inventor Narito SERIZAWA et al. | | | | | | | |
| | Art Unit 3714 | Examiner C. Coburn | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tbody><tr><td><input type="checkbox"/> applicant /inventor.</td><td rowspan="4"> Signature Amir Rohani Typed or printed name (703) 760-7757 Telephone number November 14, 2008 Date</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 61,782</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.</td></tr></tbody></table> | | | | <input type="checkbox"/> applicant /inventor. |  Signature Amir Rohani Typed or printed name (703) 760-7757 Telephone number November 14, 2008 Date | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | <input checked="" type="checkbox"/> attorney or agent of record. Registration number 61,782 | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. |
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| <input checked="" type="checkbox"/> attorney or agent of record. Registration number 61,782 | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. | | | | | | | | |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p> | | | | | | | | |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Narito SERIZAWA et al.

Serial No. 10/829,165

Filing Dated: April 22, 2004

For: IMAGE PROCESSOR AND GAME DEVICE
WITH IMAGE PROCESSOR

Examiner: Corbett B. Coburn

Art Unit: 3714

Confirmation No. 5753

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request review of the Action mailed July 14, 2008, for the reasons set forth below. Applicants are filing a Notice of Appeal concurrently herewith.

I. CLAIMS 32 AND 48-53 ARE IMPROPERLY REJECTED UNDER 35 USC 103(a)

The Examiner rejects claims 32 and 48-53 under 35 USC 103(a) using a combination of three references – Title Fight, ‘789 reference, and Logg. The Examiner’s rejection is improper because the asserted combination fails to teach all the claimed features. Although the Examiner at times admits that the cited art is deficient in teaching the claimed features, he relies on purported personal knowledge of prior art that he claims to have existed at the time of the invention to overcome the deficiencies of the asserted combination. The Examiner relies on his personal knowledge without providing any evidence or affidavit to the support his claim

regarding the state of the art at the time of the invention, even though Applicants challenged him to do so under 37 CFR 1.104(d)(2).

A. THE EXAMINER RELIES ON IMPROPER HINDSIGHT WITHOUT REGARD TO THE EFFECTIVE DATE OF THE INVENTION

In the Advisory Office Action, the Examiner states: “As Logg illustrates, changing the viewpoint during a videogame is well known. Applicant cannot seriously contest this fact – there are hundreds, if not thousands, of examples of videogames that change the viewpoint. Applicant cannot argue that changing the viewpoint is in any way, whatsoever, novel.” It is evident based on this comment, as well as other similar comments in the final Office Action, that the Examiner relies on improper hindsight and a mischaracterization of the state of the art at the time of the invention to make this rejection. The Examiner does not appear to give any consideration to the state of the art not at the time of the effective filing of the application on May 10, 1995. It is disconcerting how the Examiner makes such a claim while being unable to locate a single prior art reference that teaches, for example, the claimed transparency processing unit or the claimed viewpoint changing unit, as discussed below.

B. THE ASSERTED COMBINATION FAILS TO TEACH THE CLAIMED TRANSPARENCY PROCESSING UNIT

Claim 32 is directed to an image processing device comprising, among other features, a transparency processing unit to make a display member nontransparent. In the claimed device, the first display member is configured to be maintained in a nontransparent state until the first display member and a second display member are in a ready-to-fight state and, when the viewpoint is moved via the viewpoint changing unit such that the first display member is displayed in front of the second display member in a ready-to-fight state, the transparency processing unit is configured to make the first display member transparent. This feature is not taught or suggested by any of the references. Specifically, none of the cited references teaches a transparency processing unit that makes a display member transparent upon occurrence of an

event, i.e., upon the change of viewpoint to a ready-to-fight state while the video game is in progress.

In rejecting claim 32, the Examiner concedes that Title Fight does not teach changing transparency of a display member, but asserts that the '789 reference teaches displaying part of the display member transparent and other parts non-transparent. The Examiner then concedes that the '789 reference does not teach initially displaying a first display member as nontransparent and then making the first display member transparent when the viewpoint is moved. However, the Examiner asserts that this change in transparency would have been obvious to one of ordinary skill in the art as a matter of design choice and by changing a few parameters. Applicants respectfully disagree.

Changing transparency of a display member from non-transparent to transparent is beyond the teachings of the '789 reference and outside the scope of the art at the time of the invention. At most, the '789 reference teaches initializing the display of display members to be either transparent or non-transparent. To suggest that such teaching renders obvious changing the transparency of an element during the streaming display of a video game is highly unreasonable. The Examiner provides no evidence that such change in transparency could have been accomplished at the time of the invention by merely changing a few parameters, or that such knowledge would have been within the level of ordinary skill at the time of the invention. Further, even if the display members in the '789 reference could have been made transparent or non-transparent by changing a few parameters, the '789 reference does not suggest change in transparency while the game is in progress and while the display members are being displayed. Accordingly, the Examiner's rejection is improper.

C. THE ASSERTED COMBINATION FAILS TO TEACH THE CLAIMED VIEWPOINT CHANGING UNIT

The Examiner concedes that the combination of Title Fight and the '789 reference fails to teach moving the viewpoint. The Examiner asserts, however, that Logg teaches moving a viewpoint. Applicants respectfully disagree.

Logg merely teaches zooming in and out of a scene from a predetermined viewpoint. Logg, FIG. 10. There is no teaching or suggestion in Logg of moving the viewpoint in the manner recited in claim 32. A viewpoint as described in the specification refers to angle or position from which a display member is viewed. See specification, page 27, line 17 to page 28, line 9. Further, a viewpoint, within its plain and ordinary meaning, is defined as a "position from which something is observed or considered." American Heritage® Dictionary of the English Language (4th Ed., 2000). Logg's teaching or zooming in and out from a predetermined position does not correspond to a change in viewpoint. Accordingly, Logg fails to overcome the deficiencies of Title Fight and the '789 reference in teaching this feature.

II. CONCLUSION

In light of the above, the rejections of record are improper and should be withdrawn. A Notice of Allowance is solicited.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief, including extensions of time, and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **380412000110**.

Dated: November 14, 2008

Respectfully submitted,

By 

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